



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF APPEALS

**REPLY BRIEF**

In re the application of Jeffry A. Pegg

Filed: December 15, 2003

Serial No.: 10/734,883

Group Art Unit: 3711

Examiner: Hunter, A.

For: Vertically Mass Balanced Putter

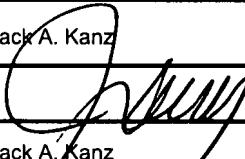
JACK A. KANZ  
for Appellant



<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application Number	10/734,883
		Filing Date	December 15, 2003
		First Named Inventor	Jeffry A. Pegg
		Art Unit	3711
		Examiner Name	Hunter, A.
Total Number of Pages in This Submission	10	Attorney Docket Number	7344.12/T

ENCLOSURES <i>(Check all that apply)</i>		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Jack A. Kanz		
Signature			
Printed name	Jack A. Kanz		
Date	24 October 2007	Reg. No.	23,061

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	
Typed or printed name	Jack A. Kanz
	Date
	23 October 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

**STATUS OF CLAIMS**

No claims have been allowed. Claims 1-8 have been rejected under 35 USC 103(a) as obvious in view of various combinations of the references cited. The claims on appeal are reproduced in the Claims in Appendix to Appellant's Second Amended Brief on Appeal filed June 20, 2007.

## **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-8 have been rejected under 354 USC 103(a) as obvious in view of various combinations of the cited references, the Examiner alleging:

“Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitabayashi (JP 2003-117033) in view of Chandler, III (USPN 6152832).

Regarding claim 1-3, Kitabayashi discloses a putter having a putterhead having a first mass and defining a top face, bottom face, and striking face which defines a horizontal axis and which extends in a substantially vertical plane from the bottom face to the top face and extends in a plane parallel to the horizontal axis and defining a preferred striking area centrally located on the striking face and a shaft having a second mass extending from the top face at an angle of 23.5 degrees supporting a grip on the end thereof remote from the putter head. Kitabayashi offsets the shaft's mounting position in order to allow left and right-handed players to utilize the club head. It is unclear if Kitabayashi discloses the vertical center of mass lying within the preferred length of the striking area, though Kitabayashi shows the clubhead being symmetric about a vertical axis, having a shaft connected and extending between the toe end and midpoint, and having an angle of 23.5 degrees. Chandler, III discloses a putter having a putter head and a shaft with grip wherein the vertical center of mass lies within the preferred length of the striking area being that the center of mass of the putter head would naturally occur at the center of the putterhead and that the handle of the shaft is substantially aligned therewith (See Entire Document). One having ordinary skill in the art would have found it obvious to have the vertical center of mass within the preferred striking area, as taught by Chandler, III, in order to promote natural pendulum movement of the arm.

Regarding claim 4, Chandler, III shows a marker that identifies the midpoint of the putter head (See Figure 1).

Regarding claim 6, see the above regarding claim 1.

Regarding claim 7, Chandler, III also shows a marker on the top face in which the marker appears to be aligned with the center of mass of the putter (See Figures 1 and 2).

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitabayashi in view of Chandler, III further in view of Redman.

Regarding claim 8, Kitabayashi in view of Chandler, III does not disclose the marker equally visible from both sides of the shaft. Redman shows the marker being equally visible on both side of the shaft. One having ordinary skill in the art would have found it obvious to have the marker of Kitabayashi in view of Chandler, III to be visible for both sides of the shaft, as taught by Redman, in order to align the golf ball with the club head.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Redman in view of Chandler, III (USPN 6152832).

Regarding claim 1, Redman discloses a putter having a putterhead having a first mass and defining a top face, bottom face, and striking face which defines a horizontal axis and which extends in a substantially vertical plane from the bottom face to the top face and extends in a plane parallel to the horizontal axis and defining a preferred striking area centrally located on the striking face and a shaft having a second mass extending from the top face at an angle of 65 degrees (25 degrees from a vertical axis with respect to the horizontal axis) supporting a grip on the end thereof remote from the putter head. Redman offsets the shaft's mounting position in order to balance the weight of the club head. It is unclear if Redman discloses the vertical center of mass lying within the preferred length of the striking area. Chandler, III discloses a putter having a putter head and a shaft with grip wherein the vertical center of mass lies within the preferred length of the striking area being that the center of mass of the putter head would naturally occur at the center of the putterhead and that the handle of the shaft is substantially aligned therewith (See Entire Document). One having ordinary skill in the art would have found it obvious to have the vertical center of mass within the preferred striking area, as taught by Chandler, III, in order to reduce twisting and to promote natural pendulum movement of the arm.”

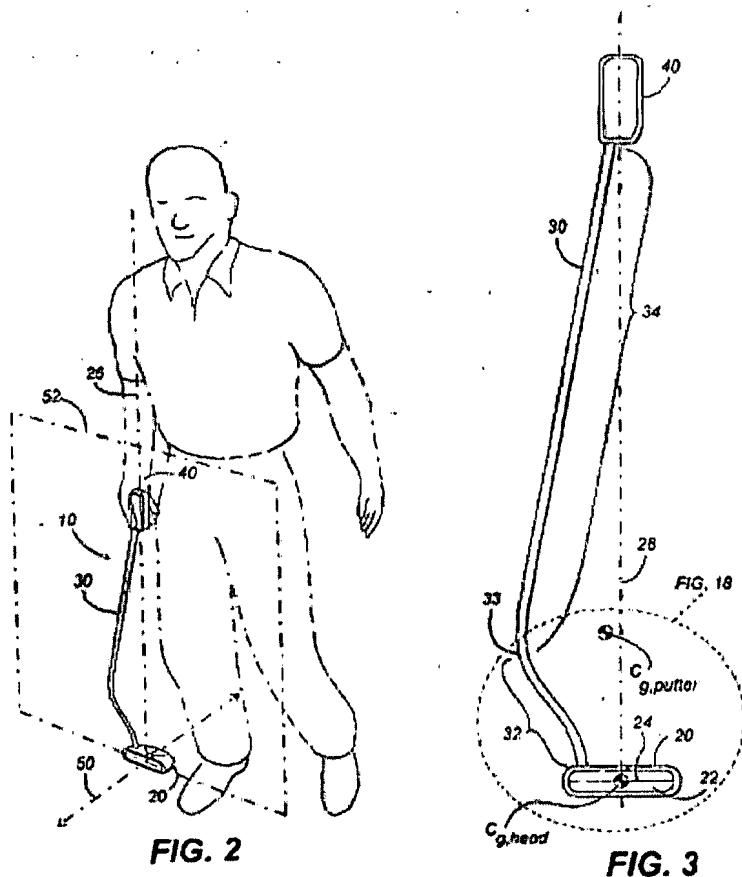
## **ARGUMENT**

This Reply Brief is supplemental to Appellant's Second Amended Brief on Appeal and addresses only the arguments in the Examiner's Answer with respect to rejections which apply to the claims on appeal. Further argument as to the patentability of the rejected claims is found in Appellant's Second Amended Brief on Appeal.

### **A. The Examiner's interpretation of "extending."**

The Examiner (Answer, par. 8) offers the facetious argument that the term "extending" as used in the rejected claims only requires the shaft to move from the direction of the top face of the putter head and, in an attempt to show that Chandler shows inclined shaft displacement as claimed, cites the abbreviated diagram shown in Fig. 16 of Chandler.

It should first be noted that the rejected claims all require "a shaft extending...at an angle of from about 8° to about 25° from vertical" while Fig. 16 of Chandler shows only the portion of the shaft extending from the putter face at angle. As noted by the Examiner, the angle of attachment at the face is not a claim limitation. Instead, the "shaft" (not the shaft *attachment* – the shaft as a whole) must extend at an angle of about 8° to about 25° from vertical. As clearly shown in Fig. 3 (see below) and disclosed at Col. 8, lines 42-52, Chandler's shaft is "vertically aligned" with the center of mass of the putter head along vertical line 26. This vertical alignment is the very essence of Chandler's claimed invention and certainly cannot be used to suggest or teach a shaft inclined at any angle. As a direct result (and intended consequence) the Chandler putter can only be used in the one-handed forward-facing stance as shown in Fig. 2 (see below).



**B. The rejection and the Examiner's "Response to Argument" fail to provide an explanation of the Examiner's fact finding sufficient to support a rejection under §103.**

In his Response to Argument (Answer pp. 6-8) the Examiner attempts to summarize Appellant's reasoned objections to the Examiner's allegations of obviousness. However, the Answer provides no factual analysis of the prior art or explanation of the factual basis on which the Examiner bases his claim of obviousness.

As stated in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. at \_\_\_\_\_, 82 USPQ 2d at 1396, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Instead of conducting a basic factual inquiry as required by *Graham v. John Deere Co.*, 383 U.S. 1, 146 S.Ct. 459 (1966), the Examiner merely selects allegedly implied conditions from the various structures without disclosing any rationale for his suggested combinations. For example, to combine a putter head of Chandler with the inclined shaft of Kitabayshi the Examiner states “one would obviously conclude that the center of gravity of the putter is within the preferred striking area” (Answer, p. 10). Where is the “rational underpinning” for this conclusion?

In the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*, 72 Fed. Reg. 57527 (Oct. 10, 2007), the USPTO set forth the following rationales upon which the Office may rely to support a legal conclusion of obviousness:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results.
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other

market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

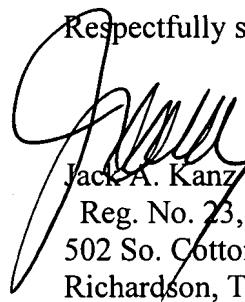
There is no evidence that the Examiner considered or relied on any of these. At best, the Examiner merely alleges that Kitabayshi shows a shaft extending from the top face of the putter head at an angle deviated from vertical and Chandler shows that yaw can be reduced by centering the shaft over the center of mass of the putter head. Nowhere does the Examiner present any rationale for his allegations that the vertical shaft of Chandler can be replaced by an inclined shaft as shown in Kitabayshi to produce the balanced putter of the claimed invention. Instead, the obviousness rejections are based solely on the Examiner's unsubstantiated assumptions that inclined but vertically mass balanced shafts *could* be substituted for non-vertically mass balanced shafts because Chandler shows a vertically aligned shaft. Without citing some reason why the combination is likely to be obvious or why the combination would produce predictable results, the rejection of Claims 1-8 as obvious cannot be supported under the rationale of *KSR International Co. v. Teleflex, Inc.*

## **CONCLUSION**

Appellant's Second Amended Brief on Appeal clearly distinguishes the fact issues and amply supports Appellant's positions. Since there is no suggestion or motivation to combine the references as suggested by the Examiner; since the combination of elements relied on by the Examiner fails to perform the same work in the same way as set forth in

the claimed invention; since there is nothing in the art cited to suggest the results achieved by the invention claimed; and since the Examiner has failed to provide any explanation of the combination rejection which would support an obviousness rejection under the requirements of *KSR International Co. v. Teleflex, Inc.*, all as set forth hereinabove and in Appellant's Second Amended Brief on Appeal herein, it is respectfully submitted that Claims 1-8 have been erroneously rejected and the rejections should be reversed.

Respectfully submitted,



Jack A. Kanz  
Reg. No. 23, 061  
502 So. Cottonwood Dr.  
Richardson, Texas 75080  
Tel 972.234.1394  
Fax 972.234.5171

October 24, 2007

ATTORNEY FOR APPELLANT